UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,520	05/31/2000	Claude M. Leglise	INTL-0391-US (P8805)	1973

7590 10/21/2003	EXAMINER

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EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>12 September 2003</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-6,8-16 and 18-27</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-6,8-16 and 18-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

     If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

         1.☐ Certified copies of the priority documents have been received.

         2.☐ Certified copies of the priority documents have been received in Application No. _____ .

         3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

     a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6) ☐ Other: .

DETAILED ACTION

Response to Amendment

This office action is responsive to amendment filled September 12, 2003.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

1.   Claims 1-6, 8-16, 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Netsurfer as taught by "Netsurfer makes it easy" Broadwatch Magazine ; Todd Judd Erickson

January 2000, in view of "ZipLink's Virtual Internet Service Provider (ISP) Program Provides

complete Turnkey Outsourcing Option PR Newswire; New York; Nov 4, 1999 (hereinafter

ZipLink).

2.   Regarding claim 1, Netsurfer teaches providing signup CD to ISP, with everything on it,

branded by an ISP; providing Internet service through graphical user interface provided by the

service provider (ISP) (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using

branded interface can provide user access to the web, and direct access to the ISP's content

partners (see page 76 col. 2 and 3). Netsurfer teaches <u>controlling the ability of the customer to</u>

<u>add software or hardware</u>. Netsurfer teaches using the Softcast the ISP push content to a user

computer and make changes to the computer and to push software updates, …and can also fix

problems including errors and software bugs… and update thirdparty software (see 78 and 80).

Netsurfer however does not teach providing Internet services to customer through a service

provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches

providing private-branded Internet connectivity, which enables e-businesses, affinity groups and

web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes

custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and

news service, etc. Ziplink teaches by using the system customers avoid the tremendous

investment of building and maintaining a national network and the cost of staffing a customer

care operation center (see page 1). Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's

branded Internet service. One would be motivated to provide private-branded Internet service to

e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the

connectivity or service and customer care function enables the customers (vendors) to

concentrate on building their business and avoid the tremendous investment of building and

maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach

providing customized advertising to the client based on preferences received form the client.

Official notice is taken to provide customized advertising to said client based on preferences

received form the client is old and well known in the art of marketing. One would be motivated

to provide customized advertising based on user preference in order to develop a one-to-one

relationship with the user, by providing a targeted content.

3.   Regarding claim 2, Netsurfer teaches customizing the content provided based on the

customer's identity (see page 78 col. 3 and page 80 col. 1-3)

4.   Regarding claim 3, Netsurfer teaches controlling the initial graphical user interface

displayed after booting of the system (see page 78 col. 1 and 2). Netsurfer teaches once the

customer place the CD in the computer the signup program uses wizards to guide the user

through the account creation and network connection processes (see page 78).

5.   Regarding claim 4, Netsurfer does not teach providing confidential information to service

provider instead of retail store. Ziplink teaches the Virtual ISP program offering a full suite of

customer card management services including customer sign-up, activation and authentication,

which indicate that all the back-end services including authentication being performed by the

Virtual ISP (see page 1). It would have been obvious to one of ordinary skill in the art at the

time of the invention to combine Netsurfer's sign-up program with Ziplink's Virtual ISP

program. One would be motivated to provide confidential information to the Internet service

provider instead of the retail vendor since the service provider is the one who is performing the

authentication.

6.   Regarding claim 5, Netsurfer teaches providing the customer with a predefined set of

selection (see page 80 and fig. 2&3).

7.   Regarding claim 6, Netsurfer teaches enabling the service provider to provide control

software and hardware added to user computer (see page 78 and 80 col. 1).

8.   Regarding claim 8, Netsurfer teaches receiving the customer preference on customer

computer coupled to the service provider over the Internet, forwarding the customer preference

to the service provider, customizing the content based on the information (see page 80).

9.   Regarding claim 9, Netsurfer teaches automatically directing the customer to a server

associated with retail vendor when the customer wishes to obtain a product or service offered by

the retail vendor (see page 78 col. 2&3). Netsurfer teaches any ISP can have a branded desktop

with its own channels and content partners and the ISP-branded interface can provide user access

the web and a direct access to the ISP's content partners (retail vendors) (see page 78, col. 2&3

and fig. 1).

10.   Regarding claim 10, Netsurfer teaches service provider uses desktop application to

control what the user sees and when, and provides e-commerce companies space on the desktop

application (see page 78). Netsurfer teaches advertising included on a home page (see fig. 1).

Netsurfer does not teach the advertising is related the vendor, which the Internet service provider

is providing service for. Ziplink teaches the Virtual ISP program being designed to complement

an organization's marketing and customer retention efforts (see page 1). It would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of

Netsurfer' desktop which includes advertisement and Ziplink's Virtual ISP program. One would

be motivated to include advertising related to the vendor, in order to allow the vendor to provide

targeted content to the subscribers. Official notice is taken that is old and well known in the art

of Internet service to provide more than two graphical user interfaces for user to access the

service. It would have been obvious to one of ordinary skill in the art at the time of the invention

to require more than two graphical user interfaces before accessing the vendor site for the

purpose of providing the user a first page, log-in page, to allow user login to the service

provider's site and a second page, homepage, to allow the user to select a site he/she would like

to access.

11.   Regarding claim 11, Netsurfer teaches providing signup CD to ISP, with everything on it,

branded by the ISP; providing Internet service through graphical user interface provided by

service provider (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches ISPs using branded

interface can provide user access the web, and direct access to the ISP's content partners (see

page 76 col. 2 and 3). Netsurfer teach preventing the customer from accessing the Internet

services from the service provider. Netsurfer teaches controlling the ability of the customer to

add software or hardware. Netsurfer teaches using the SoftCast the ISP push content o a user

computer and make changes to the computer and to push software updates, ...and can also fix

problems including errors and software bugs... and update thirdparty software (see 78 and 80).

Netsurfer however does not teach providing Internet services to customer through a service

provider, on behalf of retail vendors, it is disclosed in Ziplink (see page 1). Ziplink teaches

providing private-branded Internet connectivity, which enables e-businesses, affinity groups and

web-centric organizations, etc. to become Virtual ISPs. Ziplink teaches that the service includes

custom sign-up, activation and authentication, billing and collection, branded CD, e-mail and

news service, etc. Ziplink teaches by using the system customers avoid the tremendous

investment of building and maintaining a national network and the cost of staffing a customer

care operation center (see page 1). Therefore, it would have been obvious to one of ordinary

skill in the art at the time of the invention to combine Netsurfer's signup platform and Ziplink's

branded Internet service. One would be motivated to provide private-branded Internet service to

e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the

connectivity or service and customer care function enables the customers (vendors) to

concentrate on building their business and avoid the tremendous investment of building and

maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach

providing advertising to the client based on customer's preferences. Official notice is taken to

provide customized advertising to said client based on preferences received form the client is old

and well known in the art of marketing. One would be motivated to provide advertising based on

user preference in order to develop a one-to-one relationship with the user, by providing a

targeted content.

12.   Regarding claim 21, Netsurfer teaches a processor and a storage coupled to the processor

(customer computer), the storage storing instructions that enable the processor to obtain Internet

services. Netsurfer teaches providing signup CD to ISP, with everything on it, branded by the

ISP (see page 76 col. 3, page 78 col. 2 and 3). Netsurfer teaches when the Signup CD is loaded

on user's computer the system posts the data to a server that sets up a user account, to provide

Internet service (see page 78 col. 1&2). Netsurfer teaches using branded interface provides the

user access to the web, and direct access to the ISP's content partners (see page 76 col. 2 and 3).

Netsurfer teach loading the signup CD preventing the customer from accessing the Internet

services from the service provider. Netsurfer teaches controlling the ability of the customer to

add software or hardware. Netsurfer teaches using the Softcast the ISP push content o a user

computer and make changes to the computer and to push software updates, …and can also fix

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e-business (retail vendors) that enable them to become Virtual ISPs since outsourcing the

connectivity or service and customer care function enables the customers (vendors) to

concentrate on building their business and avoid the tremendous investment of building and

maintaining a national network, as taught by Ziplink (see page 1). Netsurfer does not teach

receiving information about preferences and providing advertising to the client based on

preferences received form the client. Official notice is taken to provide advertising to said client

based on preferences received form the client is old and well known in the art of marketing. One

would be motivated to provide customized advertising based on user preference in order to

develop a one-to-one relationship with the user, by providing a targeted content.

13.   Claims 12 and 22 are rejected as stated above in claim 2.

14.   Claim 13, is rejected as stated above in claim 3.

15.   Claims 14, 23 and 24 are rejected as stated above in claim 4.

16.   Claim 15 is rejected as stated above in claim 5.

17.   Claim 16 is rejected as stated above in claim 6.

18.   Claims 18, 26 are rejected as stated above in claim 8.

19.   Claim 19 is rejected as stated above in claim 9.

20.   Claim 20 is rejected as stated above in claim 10.

21.   Regarding claim 25, Netsurfer teaches storing instruction that enable the system to

control the initial graphical user interfaces from being changed (see page 78 col. 1&2).

22.   Regarding claim 27, Netsurfer teaches user computer, which includes housing and display (see page 78 col. 1).

Conclusion

23.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ronning U.S. Patent No. 5,907,617 teaches try before you buy software distribution and marketing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Yehdega Retta
Examiner
Art Unit 3622

YR
September 29, 2003